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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,269	10/29/2003	Tsuyoshi Uehara	021311A	4127

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EXAMINER

GREIMEL, JOCELYN

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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06/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/694,269	UEHARA ET AL.	
	Examiner	Art Unit	
	Jocelyn Greimel	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,11 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,11 and 14-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/258,734.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/06/05, 07/25/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 31 March 2007 has been entered.

Status of Claims

2. Claims 1-2, 11 and 14-18 are currently pending.

Claim Objections

3. Claims 17 and 18 are objected to because of the following informalities: claim 17 states the "server manager" – it appears it should read "server manages". Claims 17 and 18 both read "notifies said supplier system of said supplier system, said buyer system..." This wording is confusing and appears to reference an incorrect system. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 recites the limitation "first system." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-2, 11, 14-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bednar et al (US Patent No. 5,832,460, hereinafter Bednar) in view of Kitchen et al (US Patent No. 6,289,322, hereinafter Kitchen).

7. Applicant's claims are a combination of electronic funds transfer utilizing a "unique identification code" and invoice reconciliation. Bednar teaches electronic funds transfer and invoice reconciliation utilizing the transaction system proposed by Applicant. Kitchen is also a transaction system and teaches a "biller invoice number", which can be a unique identification code given by the biller as is well-known in invoice art.

8. In reference to claims 1 and 11, Bednar discloses a method, system and apparatus for managing transactions and settlements, comprising:

- a. A supplier system used by a supplier who issues an invoice (col. 2-3);
- b. A buyer system used by a buyer who receives the invoice (col. 2-3);
- c. A second finance system which has a bank account of the supplier and a first finance system which has a bank account of the buyer and performs

deposit/withdrawal processing from the bank account of the buyer to the bank account of the supplier (col. 2-3); and

d. A server which is connected communicably with the supplier system, the buyer system and the first system via a communication network(col. 2-3),

e. The server receives, from the supplier system, an electronic invoice on which a unique identification code for identifying the invoice is generated by the supplier system (col. 2-3);

f. The server registers the received electronic invoice in a database (col. 2-3);

g. The server transmits, to said buyer system, a GUI screen for showing contents of the electronic invoice registered in the database and for allowing the buyer to approve the contents of the electronic invoice, and causes the buyer system to display the GUI screen (col. 2-3);

h. The server or buyer system automatically creates a transfer request telegraphic message having the unique identification code written on the registered electronic invoice, on the basis of the registered electronic invoice approved by the buyer, in response to that the buyer has approved the contents of the electronic invoice displayed on the GUI screen by the buyer system, and then transmits the transfer request telegraphic message to the first finance system (col. 2-3);

i. Upon reception of the transfer request telegraphic message having the unique identification code, the first finance system performs the

deposit/withdrawal processing for a payment of the electronic invoice having the unique identification code (col. 2-3); and

j. The second finance system transmits, to the server or the supplier system, an electronic deposit/withdrawal detailed statement describing that a deposit is made to the bank account of the supplier, the electronic deposit/withdrawal detailed statement having the unique identification code (col. 2-3);

k. Whereby the server or the supplier is enabled to specify which one is the paid electronic invoice, by means of the unique identification code possessed by the electronic deposit/withdrawal detailed statement which is received from the finance system (col. 2-3).

Bednar does not teach the unique identification code for the invoice. However, Kitchen teaches a unique identification code or "biller invoice number" at col. 3-4 and col. 17-18. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the transaction and settlement processing system of Bednar to include a unique identification code or biller invoice number of Kitchen because it is an efficient way to track a bill in progress. Both Kitchen and Bednar teach the presentation of bills over a computer to the client via a GUI screen.

9. In reference to claim 2, Bednar discloses the transaction and settlement system further comprising the step in which when the supplier system receives the electronic deposit/withdrawal detailed statement, the supplier system automatically searches an electronic invoice having the unique identification code possessed by the

deposit/withdrawal detailed statement, from among a plurality of electronic invoices held by the supplier system, and reconciles the searched electronic invoice (col. 2-4). Bednar does not teach the unique identification code for the invoice. However, Kitchen teaches a unique identification code or "biller invoice number" at col. 3-4 and col. 17-18. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the transaction and settlement processing system of Bednar to include a unique identification code or biller invoice number of Kitchen because it is an efficient way to track a bill in progress.

10. In reference to claim 14, Bednar discloses a method, system and apparatus for transaction and settlements further comprising the steps in which:

- l. The server registers a status of the registered electronic invoice in a database (col. 2-3 ;
- m. The first finance system notifies the server of a withdrawal from the bank account of the buyer by means of deposit/withdrawal processing (col. 2-3);
- n. The server updates the status of the electronic invoice managed in the database to transfer request in progress, when the transfer request telegraphic message is transmitted to the first finance system or when the finance system notifies of a withdrawal from the bank account of the buyer by the deposit/withdrawal processing (col. 2-3); and
- o. The server notifies the supplier system of the updated status (col. 2-3).

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11. In reference to claim 15, Kitchen discloses the transaction and settlement method, system and apparatus further comprising the step in which:

p. The server updates the status of the electronic invoice managed in the database to an opened status, when transmitting, to the buyer system, the GUI screen showing the contents of the electronic invoice, and causing the buyer system to display the GUI screen (col. 3-4, Figure 15).

12. In reference to claims 17 and 18, Kitchen teaches the transaction and settlement method, system and apparatus further comprising the step in which:

q. Wherein the server manages the status of each electronic invoice as opened, transfer request in progress, and paid, and notifies at least the supplier system of the supplier system, the buyer system, and the second finance system and the first finance system of the electronic invoice status using the unique identification code (col. 3).

13. **Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kitchen in view of Bednar as applied to the claims above, and further in view of *Quicken vs. Money* from SmartComputing (hereinafter Quicken).** In reference to claim 16, the combination of Kitchen and Bednar (above) disclose bill presentation over a network utilizing a GUI screen and a unique identification code. However, Kitchen and Bednar do not disclose the transaction and settlement system further comprising:

- r. A calendar GUI preparation step in which the server prepares a calendar GUI screen displaying a calendar;
- s. And invoice mark pasting step in which the server automatically pastes a mark indicating the electronic invoice registered in the database and the status of the electronic invoice managed in the database, in a space for a date of receipt of the electronic invoice, on the calendar of the GUI screen;
- t. A calendar GUI supplying step in which the server supplies the calendar GUI screen that has the mark on the electronic invoice and the status thereof pasted thereon, to the buyer system, and causes the buyer system to display the calendar GUI screen; and
- u. A mark changing step in which the server changes the display of the mark pasted on the calendar to display showing the status obtained after the change, in response to a change of the status managed in the database for the electronic invoice indicated by the mark.

However, Quicken discloses the above steps. Quicken discloses “financial programs let you pay bills electronically”, “you can track bank accounts, pay and receive bills online, create budgets, choose from 30 reports and graphs, and use limited investment tracking” (page 2). It details how “Quicken Deluxe 99’s financial calendar let you drag and drop transactions to schedule them for future payments” (page 2). Additionally, Quicken discloses “Money 99 Basic now contains a financial calendar that lets you see and sort paid bills and those that are still upcoming. With the E-bills feature, you can receive and pay bills through the Internet” (page 4). It would have been obvious to one

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of ordinary skill in the art at the time of the Applicant's invention to have modified the bill presentation system over a network utilizing a GUI screen and a unique identification code of Kitchen and Bednar to include a GUI calendar screen taught by Quicken because it would assist in presenting the client with bill information, making the system easier to use.

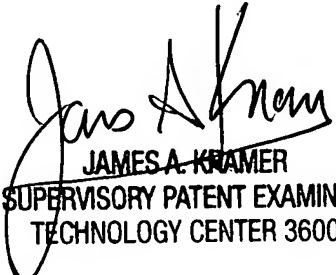
Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jocelyn Greimel whose telephone number is (571) 272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
May 31, 2007

 6/4/07
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